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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,224	01/22/2004	Melvin Lee Jacobson	J274.12-0001	9161

164 7590 10/07/2005  
KINNEY & LANGE, P.A.  
THE KINNEY & LANGE BUILDING  
312 SOUTH THIRD STREET  
MINNEAPOLIS, MN 55415-1002

EXAMINER

ROWAN, KURT C

ART UNIT PAPER NUMBER

3643

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/764,224

Applicant(s)

JACOBSON, MELVIN LEE

Examiner

Kurt Rowan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5-10 and 12-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-10 and 12-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for securing the pest to the first side of the substrate by adhering the substrate to the body surface so that the substrate covers and conforms to the body surface and the pest must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. 2002/0112395 A1 for substantially the same reasons stated in the first Office Action.

The Patent Application Publication '395 to Marsh shows an insect removal device 2 having an engagement surface (not labeled) covered with an adhesive layer 4, a backing side (not labeled) positioned opposite the engagement side, and a single release tab 6 covered with a tab liner 10 as shown in Fig. 1. Marsh shows the device for removal of a pest from a surface of a body of an animal or human. The main body is configured to conform to and attach to the surface to cover and smother the pest. Marsh shows the adhesive layer is composed of a material that is not irritating to human skin of animal skin. Marsh show means such as the adhesive covered substrate for causing the pest to release from the surface since as shown in Fig. 4, the pest will be smothered by the adhesive which will cause the pest to release from the surrounding surface of a body. Marsh does not disclose that the pest removal device is placed on the skin of a body, but shows the device covering the pest at a point above the skin of a

body. However, it would have been obvious that the device could be placed in contact with the skin of a body to obtain a more secure grasp of the pest by the adhesive.

3. Claims 1, 5, 10, 12-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grueling in view of Byom.

The patent to Grueling shows a pest removal device for removing a pest from a surface having a main body with an engagement side 7, 8 covered with an adhesive layer 13, 14 as shown in Fig. 5. Grueling shows a backing side positioned opposite the engagement side and wherein the main body is configured to be applied to the surface to cover and smother the pest. Grueling shows a single release tab 11, 12 extending from an outer edge of the main body and covered with an adhesive layer 15, 16.

Grueling does not disclose a tab liner attached to the adhesive layer. The patent to Byom shows a pest removing device having a tab liner 8, 9 attached to the adhesive layer. In reference to claims 1, 12 and 19, it would have been obvious to provide the adhesive layer of Grueling with a liner as shown by Byom for the purpose of preventing the adhesive from drying out. The pest removal device of Grueling as modified by Byom is configured to and attach to the surface to smother and cover the pest. It would have been obvious to employ an adhesive layer that is composed of a material that is not irritating to human skin or animal skin for the purpose of making the device pleasant to use. In reference to claims 13-14, the pest removal device of Grueling as modified by Byom does not disclose that the main body defines a diameter of a circle with a half circular tab, but it would have been obvious to change the shape of the main body and

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tab to a circle and half circle since the function is the same and no stated problem is solved. See *In re Dailey et al.*, 149 USPQ 47. In reference to claims 10 and 15, Grueling discloses an adhesive 4 on both sides of the main body 1 as shown in Fig. 2a. In reference to claim 16, Byom discloses that the release tab 21 is covered with a tab liner 9 as shown in Fig. 1. In reference to claim 17, the combination of Grueling and Byom do not disclose that the main body and release tab are constructed from a flexible resilient foam material. However, it would have been obvious to employ resilient foam since the selection of a known material is based on its suitability for the intended use. See *In re Leshin*, 125 USPQ 416.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grueling as modified by Byom as applied to claim 1 above, and further in view of Marsh et al. for substantially the same reasons stated in the last Office Action.

The patent to Grueling and Byom show pest removing devices as discussed above. Grueling and Byom do not disclose an antiseptic penetrating the adhesive layer. In reference to claims 6-7, Marsh discloses that the adhesive layer is penetrated with an antiseptic in paragraph 16. it would have been obvious to provide the pest removal device of Grueling as modified by Byom with an antiseptic as shown by Marsh to kill bacteria on and around the pest. In reference to claim 7, it would have been obvious to provide Grueling as modified by Byom and Marsh with alcohol which is an old and well known antiseptic. In reference to claim 11, Marsh discloses removing a pest from human skin as shown in Fig. 4 and also see paragraph [0014].

6. Claims 8, 9, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grueling in view of Byom as applied to claim 1 above, and further in view of Nelson '862 for substantially the same reasons stated in the last Office Action.

The patents to Grueling, Byom and Nelson show insect capturing devices. Grueling and Byom have been discussed above and do not show the liner spooled in a dispenser. In reference to claims 8, 18, and 20, the patent to Nelson shows an insect capturing device with storing liner 50 as shown in Fig. 16. It would have been obvious to provide the pest capturing device of Grueling as modified by Byom with a storage liner as shown by Nelson for the purpose of holding a plurality of capturing devices together during transport. In reference to claims 9 and 21, it would have been obvious to provide the insect capturing device of Grueling as modified by Byom with a storing liner spooled on a dispenser shown in Fig. 9a of Nelson to conveniently carry more than one insect catcher at a time. In reference to claim 22, Grueling shows a second layer of adhesive 4 covering the second side of the substrate 1 in Fig. 2a.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grueling in view of Byom as applied to claim 1 above, and further in view of Marsh and Nelson. The patents to Grueling, Byom, Marsh and Nelson show insect capturing devices and have been discussed above. In reference to claim 24, it would have been obvious to provide the insect capturing device of Grueling as modified by Byom with a material (as disclosed in paragraph 0016) incorporated into the adhesive to cause the pest to release from the surface as shown by Marsh and a storing liner as shown by Nelson in Fig. 16 to store a plurality of capture devices.

6. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al in view of Nelson '862.

7. The patent to Marsh shows an insect removal device as discussed above. Marsh shows providing a pest removal device (as described above in reference to claim 23), positioning the engagement side completely over the pest (as shown by Marsh in Fig. 3), securing the pest removal device to the pest, pulling the single release tab, and removing the pest removal device with the pest attached to the engagement side of the pest removal device (as shown in Fig. 4). Marsh does not disclose attaching the pest removal device to the skin or the surface. The patent to Nelson shows attaching the pest removal device to the surface and the pest as shown in Fig. 5. In reference to claim 25, it would have been obvious to provide Marsh with the step of attaching the pest removal device to the pest and the surface as shown by Nelson for a time sufficient to cause the pest to release from the surface. Since Marsh discloses an antiseptic, which will kill the pest in time, it appears that the pest would try to escape the antiseptic by releasing from the surface. In reference to claim 26, Nelson shows a storage liner 110. In reference to claim 27, both Nelson and Marsh show folding the pest removal device to trap the pest. Nelson shows folding the pest removal device after peeling the device from the body surface to trap the pest as shown in Fig. 5 and Fig. 6. In reference to claim 28, Nelson discloses disposing of the pest removal device in column 7, lines 32-33. In reference to claim 29, neither Marsh or Nelson disclose saving the pest attached to the pest removal device and analyzing the pest for disease,



but it would have been obvious to study the pest for disease to determine if more medical treatment is required.

8. Claims 12-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al.

The patent to Marsh shows a pest removal device as discussed above. Marsh shows a main body 2 having a length, a width, and an outer edge. Marsh shows the main body formed of a flexible resilient foam material as disclosed in page 1 paragraph numbered [0011]. Marsh shows an engagement side covered with an adhesive layer 4 and a backing side positioned opposite the engagement side. The main body is substantially flat and shows the structure capable of being attachable to the surface by the adhesive layer to cover and smother the pest. Marsh shows a release tab 6 extending from (beyond) an outer edge as shown in Fig. 1. Marsh shows the release tab is graspable to apply a pulling force as shown in Fig. 4 to the center and hence to the outer edge of the main body to peel the main body off the surface. Marsh shows the release tab having a length parallel to the main body length in Fig. 1. Marsh does not disclose that the tab has a length less than the main body length and a width less than the main body width, but it would have been obvious to employ a tab with a length and width less than the main body width since the size of the tab would be determined through routine experimentation. See *In re Dailey et al.*, 147 USPQ 47. Marsh does not disclose the use of a hypoallergenic pressure sensitive adhesive, but states that the adhesive would be well known to one skilled in the art as stated on page 1 in paragraph numbered

[0011]. Hence it would have been obvious to employ a hypoallergenic pressure sensitive adhesive.

### ***Response to Arguments***

9. Applicant's arguments filed July 14, 2005 have been fully considered but they are not persuasive. Applicant argues that Marsh does not show the means plus function limitations recited in claim 23. This has been discussed in the above rejection of claim 23. It should be pointed out that Marsh does show equivalent structure and that merely, the method of use is slightly different. However Marsh show the structure to perform that use and it would have been obvious to use Marsh in the manner recited since the function is the same and no stated problem was solved. As to the combination of Grueling in view of Byom, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. Also, there is a reasonable expectation of success and the prior teaches or suggests when combined all of the claim limitations. Applicant argues that no one would consider using fly paper by applying it to the skin of an animal or human, and that the type of adhesive used on fly-catching paper is not skin friendly, but applicant has submitted no evidence as to

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why this would be the case. In reference to claim 12, the use of hypoallergenic adhesive would have been obvious since the selection of a know material is based on its suitability for the intended use. See *In re Leshin*, 125 USPQ 416. Marsh also states that the selection of a suitable adhesive would be well known to one skilled in the art which would also make claim 24 obvious to one skilled in the art. Hence, it would have been obvious to employ a skin friendly adhesive. In regard to the adhesive being used to suffocate the pest, the proposed combination would also suffocate the pest and cause it to release from the surface of the body. The argument that Nelson does not contain a skin friendly adhesive has been considered. There is no evidence that the pest removal device of Marsh could not be left on for a long period of time. However, there is no support in the specification for what a long period of time exactly is.

Applicant states that up to 30 minutes could be employed for deeply embedded pests, but it is not clear if constitutes a long period of time or not. At any rate it appears that the prior art pest removal devices such as Nelson could be left on for as long as the that of the present invention. As to Claims 25-29, since the combination of Marsh and Nelson show the same structure as that recited, why would the pest not release itself from the surface of the body ? It should be pointed out that applicant is arguing method of use limitations in an article claim and that the prior art has the same structure. In regard to Marsh and claim 12, Marsh can be considered as substantially flat when viewed as in Fig. 1. Marsh also shows the pest being smothered as in Fig. 4 as the pest is grasped and pulled away from the point of attachment. Since Marsh disclose moving the hair of an animal or human away from the pest attachment location, the

device is likely to come in contact with the skin and hence the device will be peeled off the body surface of the animal or human with the tab 6 being at an edge of the main body surface.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a long, sweeping horizontal stroke extending to the right.

Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR